

**REMARKS**

In this communication, Claim 7, 26, 30, and 36 were amended. No claims were cancelled or added. Claims 8, 9, 11-15, 31-35, and 39 were previously withdrawn from examination. As such, Claims 7, 10, 16-30, 36-38, and 40 are currently under examination. The Examiner's rejections are as follows:

- I) Claims 7, 10, 16-24, 26, 28, 30, 36, 38, and 40 were rejected under 35 U.S.C. 103(a) as allegedly unpatentable over Soares et al. (U.S. Pat. 5,830,662) and Lorincz et al. (U.S. Pat. 6,136,535); and
- II) Claims 25, 27, 29, and 37 were rejected under 35 U.S.C. 103(a) as allegedly unpatentable over Soares et al. and Lorincz et al. as applied to Claims 25 and 36, and further in view of Hall et al. (U.S. Pat. 5,994,069).

**I. Obviousness Rejection Over Soares et al. and Lorincz et al.**

The Examiner rejected Claims 7, 10, 16-24, 26, 28, 30, 36, 38, and 40 under 35 U.S.C. 103(a) as allegedly unpatentable over Soares et al. (U.S. Pat. 5,830,662) and Lorincz et al. (U.S. Pat. 6,136,535) (Office Action, page 3). Applicants respectfully disagree with this rejection and submit that no *prima facie* case of obviousness has been established. For example, Applicants respectfully submit that the combination of Lorincz et al. and Soares et al. does not teach<sup>1</sup> all the elements of the claims as explained below.

*i. Lack of Teaching in Combined Art*

All of the pending claims require the following method step:

- (3) annealing an anti-sense promoter oligonucleotide to the sense promoter containing first-strand cDNA to obtain a transcription substrate;

Neither Lorincz et al., nor Soares et al. teach this step.

In regard to Soares et al., the Examiner agrees that this reference does not describe this step stating:

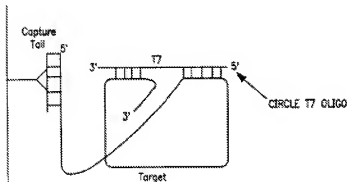
... Soares et al. do not specifically teach the limitation of:

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<sup>1</sup> Applicants also note that there is no motivation to combine the cited references and no reasonable expectation of successfully combining the references. However, such a discussion is moot given the clear lack of teaching of all the elements of the claims in the cited art.

(3) annealing an anti-sense promoter oligonucleotide to the sense promoter containing first-strand cDNA to obtain a transcription substrate. (Office Action, page 4).

In regard to Lorincz et al., the Examiner cites the "circle T7 oligo" in Figure 4 of this reference as teaching an anti-sense promoter oligonucleotide (see Office Action, pages, 5, 8, and 9). However, Applicants respectfully submit that Figure 4 of Lorincz et al. does not show an anti-sense promoter oligonucleotide annealing to a sense promoter containing first-strand cDNA. For example, the "circle T7 oligo" shown in Figure 4 of Lorincz et al. is not hybridizing to a "sense promoter containing first-strand cDNA" as required by the pending claims as the "target" sequence shown in Figure 4 does not contain a "sense promoter." The only promoter sequence shown in Figure 4 is the middle section of the "circle T7 oligo" which is labeled "T7." This T7 section, like the other "promoter-primers" described in Lorincz et al., is flanked by 5' and 3' non-promoter regions that are designed to simply be complementary to the target sequence (see, Lorincz et al., *entire reference*, which describes the design of such promoter-primers). The lack of a sense-promoter sequence in the target sequence is clearly shown in the portion of Figure 4 pasted in below:



The promoter-primer shown in the above figure of Lorincz et al. clearly does not show a sense promoter primer as defined in the present specification, and also it does not show annealing of an anti-sense promoter oligonucleotide to the sense promoter sequence. Therefore, this is not relevant to the claims of the present invention.

In light of the above, it is clear that the combined teaching of Soares et al. and Lorincz et al. do not teach the step of annealing an anti-sense promoter oligonucleotide to a sense-promoter containing first strand cDNA as recited in the present claims. As such, Applicants submit that no *prima facie* case of obviousness has been established and the present rejection should be

withdrawn.

*ii. Claim Amendment*

Despite the clear lack of teaching in the combined art, in order to expedite the prosecution of the present application, without acquiescing to the Examiner's rejection, while reserving the right to prosecute the original or similar claims in the future, Applicants have amended the claims. In particular, Claims 7, 26, 30, and 36 have been amended to specify that the anti-sense promoter oligo anneals to the sense promoter in the circular sense promoter-containing first-strand cDNA. Support for this amendment is found throughout the specification including, for example, Figure 1. Applicants respectfully submit that this amendment further distinguishes over the cited art as neither reference teaches annealing an anti-sense promoter oligo to the sense promoter in a circular sense promoter containing first strand cDNA.

**II. Obviousness Rejection Over Soares et al., Lorincz et al., and Hall et al.**

The Examiner rejected Claims 25, 27, 29, and 37 under 35 U.S.C. 103(a) as allegedly unpatentable over Soares et al. and Lorincz et al. as applied to Claims 25 and 36, and further in view of Hall et al. (U.S. Pat. 5,994,069) (Office Action, page 10). Applicants respectfully submit that this rejection fails for the same reasons outlined above as Hall et al. does not teach annealing an anti-sense promoter to a sense promoter in a circular sense promoter-containing first strand cDNA and therefore does not make up for the lack of teaching in Soares et al. and Lorincz et al. As such, Applicants respectfully submit that this rejection should be withdrawn.

**CONCLUSION**

Should the Examiner believe that a telephone interview would aid in the prosecution of this application, Applicants encourage the Examiner to call the undersigned at 608-218-6900.

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